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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,213	01/22/2004	Christine Rondeau	05725-0384-01	2722
22852	7590	04/27/2006		EXAMINER
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			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 04/27/2006

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/761,213
Filing Date: January 22, 2004
Appellant(s): RONDEAU, CHRISTINE

MAILED

APR 21 2006

GROUP 1700

Adriana Burgy
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 13, 2006 appealing from the Office action mailed December 21, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. However, Appellant brings to the Board's attention the Decision by the Board in the parent application which is identified in the Related Proceeding Appendix.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

DE 29512302	Kao Corp	1-1997
WO 95/01772	Mockli	1-1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-42 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Cotteret in view of Mockli.

Cotteret, U.S. Patent No. 5,735,908, teaches that the addition of a cationic or amphoteric substantive polymer to oxidation dye compositions which contain a p-phenylenediamine of formula (I) and preferably a coupler results in enhanced selectivity, increased intensity and uniformity, and improved fastness properties, see col. 1, line 50-col. 2, line 18. Cotteret's preferred polymers include those as claimed, e.g. Polyquaternium-24, -37, -32 and -35, and Merquat 280, wherein the polymers are present in the claimed amounts, see col. 3, line 26-col. 4, line 60. Cotteret also teaches couplers as claimed as preferred for addition to such compositions, and that such compositions may contain direct dyes, see col. 5, lines 39-52. Cotteret also teaches that direct dyes may be added to the dyeing compositions, and that their dyes may be chosen from azo, nitro and anthraquinone dyes. See col 5 lines 53 et seq as well as col 6 lines 5 and 6. Cotteret fails to teach the addition of the specific direct dyes as claimed.

Mockli, WO 95/01772, teaches compositions for dyeing keratin fibers, particularly human hair, which comprise at least one cationic dye of formulae (1) to (6), which dyes overlap in scope with those as claimed, see Abstract and page 2, line 4-page 8, line 19. Mockli's preferred dyes include preferred dyes of formulae (I), (II), (III) and (III') as

claimed, see Examples such as Examples 2-4, 11, 22, 46 and 65. Mockli teaches that the dyes may be mixed with assistants customarily used in cationic dye-containing hair dye compositions, including cationic conditioning polymers (i.e. Polyquaternium 6), see page 11, lines 1-2 and Example 1. Mockli teaches that the patentee's dyes result in dyeings with improved color strength, and have improved light-, shampoo- and friction-fastness properties as compared to conventionally used cationic (direct) dyes such as Basic Blue 99, Basic Brown 16 and 17, Basic Red 76 and Basic Yellow 57, see page 1, lines 13-25 and Examples 1-6.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a composition for dyeing hair in the claimed forms which contain an oxidation base and cationic dye as claimed in the claimed amounts, a coupler in the claimed amounts, and a cationic or amphoteric polymer, oxidants, other direct dyes, and solvents as claimed, wherein the compositions may have pH's as claimed and may be forms as claimed, and wherein the compositions may be applied to hair in dyeing methods as claimed, because such compositions, methods fall within the scope of Cotteret's teachings. It would have been obvious to those skilled in the art to select a cationic dye as taught by Mockli as the direct dye in the composition of Cotteret because Mockli teach that said dyes are compatible with the cationic polymers, for example the polyquaternium polymers, that Cotteret uses, and Cotteret teaches that the claimed polymers result in various improved properties such as improved selectivity when used in oxidation dyeing compositions. Cotteret applies the dyes in the methods claimed, premixing with hydrogen peroxide before applying to the hair. See examples.

It would have been obvious to one having skill in the art to provide the compositions in the kit as claimed in claim 40, since that is how oxidation hair dyes are ordinarily provided to the consumer, in order to have a premeasured amount of dye and oxidant to mix directly before application.

Claims 1-23, 32-36 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kao Corp in view of Mockli.

Kao Corp, DE 29512302, teaches compositions for dyeing or toning human hair which comprise a direct dye and a hydroxyalkyl guar gum or a quaternary salt thereof. See English language abstract. The direct dyes include cationic dyes such as Basic Blue 99, Basic Brown 16 and 17, Basic Red 76 and Basic Yellow 57 (which read on the claimed additional direct dyes), and may be present in the claimed cationic dye amounts. See page 3 of the English translation for the dyes lines 20 and page 6 line 4. Kao Corp teaches that the compositions may also contain conditioning polymers in the claimed amounts, including specifically claimed polymers of dimethyldiallyl ammonium chloride and cationic vinylpyrrolidones. See page 4 of the translation fourth paragraph. The compositions are aqueous, may have the pH as claimed, and may be present in the claimed amounts. See English translation page 2 and page 5. Kao Corp exemplifies various compositions which contain basic direct dyes in combination with a cationic conditioning polymer which are applied to hair in dyeing methods as claimed. See the examples on page 5 of the translation. Kao does not teach cationic direct dyes of the claimed formulae.

Mockli, WO 95/01772, teaches compositions for dyeing keratin fibers, particularly human hair, which comprise at least one cationic dye of formulae (1) to (6), which dyes overlap in scope with those as claimed, see Abstract and page 2, line 4-page 8, line 19. Mockli's preferred dyes include preferred dyes of formulae (I), (II), (III) and (III') as claimed, see Examples such as Examples 2-4, 11, 22, 46 and 65. Mockli teaches that the dyes may be mixed with assistants customarily used in cationic dye-containing hair dye compositions, including cationic conditioning polymers (i.e. Polyquaternium 6), see page 11, lines 1-2 and Example 1. Mockli teaches that the patentee's dyes result in dyeings with improved color strength, and have improved light-, shampoo- and friction-fastness properties as compared to conventionally used cationic (direct) dyes such as Basic Blue 99, Basic Brown 16 and 17, Basic Red 76 and Basic Yellow 57, see page 1, lines 13-25 and Examples 1-6.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate an aqueous composition in the claimed forms for dyeing hair which comprises a cationic dye in the claimed amounts and a cationic polymer as claimed in the claimed amounts, wherein the composition has a pH as claimed and is applied to hair in dyeing methods as claimed, because such dyeing compositions and methods fall within the scope of those taught by Kao Corp. Furthermore, Kao Corp's teaching that the claimed polymers are used to condition the hair would have motivated those skilled in the art to add such polymers to the patentee's compositions in order to get improved conditioning results. It would have been obvious to those skilled in the art at the time the invention was made to at least

partially substitute the cationic dyes in Kao's compositions with a cationic dye as claimed because Mockli teaches that the claimed dyes result in improved color strength and fastness properties as compared to the dyes used by Kao Corp. Mockli also teaches that the dyes may be mixed with customary hair dyeing additives, including cationic conditioning polymers, suggesting their compatibility in Kao Corp's compositions which contain substantive polymers as claimed.

(10) Response to Argument

These two rejections are maintained as applied in the non-final rejection. They are the same rejections which were affirmed by the board of appeals in the decision in the parent case 09/278,176 on 11/25/03. The arguments herein need not be considered since the board has already affirmed the *prima facie* obviousness of the rejections. The Declaration will now be considered.

The Declaration under 37 CFR 1.132 filed October 26, 2004 is insufficient to overcome the rejection of claims 1-42 based on Cotteret in view of Mockli and the rejection of claims 1-23, 32-36, 41 and 42 based upon Kao Corporation in view of Mockli as set forth in the last Office action for the following reasons.

In the declaration, Applicant compared three compositions:

- 1) One inventive composition comprising a single dye within the scope of the cationic dyes claimed combined with a quaternary ammonium polymer as claimed.
- 2) A composition comprising the same dye as in composition 1) combined with a cationic guar polymer. Composition A

3) A direct dye which is not cationic and not within the scope of the claimed dyes combined with the same quaternary ammonium polymer as claimed in composition 1.

Composition B

Applicant states that composition I is the inventive composition and composition A represents the Kao composition and composition B represents the Cotteret composition. The statement that composition A represents the Kao composition is not accurate because Kao was relied upon to teach the addition of cationic conditioning polymers to hair dyeing compositions containing basic (cationic) dyes. Kao Corp teaches that the compositions may also contain conditioning polymers in the claimed amounts, including specifically claimed polymers of dimethyldiallyl ammonium chloride and cationic vinylpyrrolidones. See page 4 of the translation fourth paragraph.

Applicant did not compare a composition within the scope of Kao containing either dimethyldiallyl ammonium chloride or cationic vinylpyrrolidones polymers and a basic dye. Additionally, the cationic guar polymer falls within the scope of a cationic cellulose polymer as claimed. Kao suggests two of appellant's specifically claimed polymers combined with basic dyes (cationic dyes).

Regarding the comparisons themselves, it appears that applicant has compared the inventive composition with a composition containing a direct dye which shows that that particular basic dye of the inventive composition 1 has different dye uptake properties from the dye which is not cationic. That comparison has no probative value because it is not commensurate in scope with the claims. Declarant states that the comparison shows that the lower value of delta E will produce a homogeneous color

along the keratin fiber. That analysis is not understood. It appears that applicant is measuring the color coordinates before and after dyeing which measures the amount of dye uptake. It is unclear how that relates to a more homogeneous **color along the keratin fiber**. Even if the comparison were convincing, it is not commensurate in scope with the claimed subject matter. A direct comparison with the compositions of the reference is required. Said comparison must be commensurate in scope with the claims. One exemplification of the claimed composition will not overcome the rejection.

Applicant is directed to M.P.E.P716.02 (d) and (e) for the requirements of comparisons which will overcome a *prima facie* case of obviousness. Objective evidence of unobvious results must be commensurate in scope with the claims. *In re Prater*, 162 USPQ 541; *In re Tiffin*, 172 USPQ 292; *In re Linder*, 172 USPQ 356; *In re Greenfield*, 197 USPQ 227

Where unobvious results are relied upon as a basis for patentability, a proper comparative showing is a minimum requirement. *In re Eisenhut*, 114 USPQ 287 The Rondeau declaration provides comparative testing of three compositions: the inventive compositions and composition A and composition B: Applicant states that Composition A comprising basic dye and cationic guar comprises the prior art to Kao; composition B is relevant to the composition of Cotteret and Mockli.

Discussion of the Inventive composition: There is one and only one composition that is representative of the invention. The board is invited to inspect claim 1 of this invention. Claim 1 is 8 pages long and comprises a plethora of individual dyes, each of which is claimed in combination with any of five different categories of cationic or

amphoteric substantive polymers. The Inventive composition cannot have any probative value since it cannot be extrapolated to be relevant to the millions of compositions included within the scope of the claimed invention. It comprises only one dye and only one polymer.

Discussion of Composition A: This composition comprises the same dye as in the inventive composition combined with quaternized hydroxypropyl guar. Appellant states that this composition corresponds to the composition of Kao. Appellant states (1) that she should not be required to compare compositions which are not within the scope of the prior art and accordingly she need not add the particular polymers suggested by Kao since they are optional. In this statement appellant is agreeing that Kao indeed suggests the addition of the cationic conditioning polymers to his compositions. Thus the compositions comprising the polymers listed on page 4 of Kao are indeed within the scope of that prior art. Composition A is not the composition taught by Kao on which the rejection was based, nor is it the composition taught by the combination of Kao in view of Mockli on which the rejection was made. The composition of Kao on which the rejection rests is a composition comprising **a cationic dye** selected from those taught in Kao (see list on page 2 and examples on page 5), **cationic guar and also one of the polymers as claimed which is suggested by Kao (see page 4 third paragraph below the list of dyes)** and which also falls within the scope of the claimed compositions. These compositions comprising the basic dyes listed in the examples of Kao comprise the closest prior art of Kao. Composition A comprises a claimed dye, not a dye disclosed in Kao. Several of these compositions need to be tested, all comprising

the polymers claimed which are disclosed in Kao. These need to be compared to the very same compositions differing only in that the basic dyes suggested by Kao are replaced in several different examples by dyes within the scope of all of the formulae in the claims, which are the dyes of Mockli. These compositions have not been compared.

Applicant states that Mockli discredits the preferred cationic dyes of Kao. That is correct. He states that his dyes are an improvement over the dyes of Kao, which makes it *prima facie* obvious to replace the dyes of Kao in the compositions of Kao with the dyes of Mockli. However, the compositions of Kao which constitute the closest prior art are the composition of basic dye + cationic guar + applicant's claimed polymer selected from the list in Kao. Appellant is incorrect in suggesting that this office wants a comparison of the composition of Kao which comprises the conditioning polymer without the cationic guar. That would not be the composition disclosed by Kao.

In summary composition A is not the closest prior art to Kao as it does not contain a dye suggested by Kao nor does it suggest the conditioning polymers suggested by Kao and also within the scope of the claimed polymers in addition to the guar taught by Kao. In addition more than one composition need be compared since more than one of the claimed polymers is disclosed. For these reasons the rejection of the claims over Kao in view of Mockli has not been overcome by the declaration.

Discussion of Composition B: Composition B comprises a neutral dye along with a cationic polymer in an effort to overcome the rejection of the claims over Cotteret in view of Mockli. There is one and only one composition that is representative of the

composition of Cotteret. The board is invited to inspect claim 1 of this invention. Claim 1 is 8 pages long and comprises a plethora of individual dyes, each of which is claimed in combination with any of five different categories of cationic or amphoteric substantive polymers. Composition B cannot have any probative value since it cannot be extrapolated to be relevant to the millions of compositions included within the scope of the claimed invention. It comprises only one dye and only one polymer. It does not comprise the composition of Cotteret, nor does it address the other claimed cationic polymers within the scope of Cotteret. The composition of Cotteret comprises a particular oxidation base and at least one cationic or amphoteric substantive polymer as claimed. Composition B, accordingly, is not the composition of Cotteret since it lacks the necessary oxidation base of Cotteret. A proper comparison with Cotteret would be the composition comprising an azo direct dye as suggested by Cotteret (note : that is because Cotteret suggests the addition of azo direct dyes) added to the composition of Cotteret (see abstract and/or examples) compared with several examples of the composition of Cotteret each comprising one of the claimed polymers taught by Cotteret and also a dye within the scope of the claimed dyes. In other words the composition which represents the closest prior art to Cotteret must be:

- (a) para-phenylenediamine substituted in the 2-position on the benzene ring with C1-C4 hydroxyalkyl or hydroxyalkoxy radical
- (b) at least one cationic or amphoteric substantive polymer within the scope of the claimed polymers
- (c) an azo direct dye

The comparison composition representing the invention must be the same composition wherein © is replaced by a dye within the scope of the claimed dyes. At least one composition comprising the dyes of each claimed dye formulas must be tested; several of these compositions comprising each of the claimed polymers must be tested. Since applicant has not tested a composition within the scope of Cotteret, the rejection of the claims over Cotteret in view of Mockli has not been overcome.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Margaret Einsmann

Margaret Einsmann

Conferees:

Douglas McGinty

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